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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,220	06/16/2006	Atsushi Miyazaki	JFE-06-1129	7655

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IP GROUP OF DLA PIPER LLP (US)  
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1650 MARKET ST, SUITE 4900  
PHILADELPHIA, PA 19103

EXAMINER
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FOGARTY, CAITLIN ANNE

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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07/22/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,220	<b>Applicant(s)</b> MIYAZAKI ET AL.	
	<b>Examiner</b> CAITLIN FOGARTY	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-33 is/are pending in the application.
- 4a) Of the above claim(s) 18, 19 and 22-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-17, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 13, 2009 has been entered.

### ***Status of Claims***

2. Claims 13 – 33 are pending where claims 18, 19, and 22 – 33 have been withdrawn from consideration. No claims have been amended. Claims 1 – 12 have been cancelled.

### ***Status of Previous Rejections***

3. The 35 U.S.C. 103(a) rejection of claims 13 – 17, 20, and 21 as being unpatentable over Kawabata et al. (US 5,626,694) has been maintained.

The provisional nonstatutory obviousness-type double patenting rejection of claims 13 – 17, 20, and 21 as being unpatentable over claims 1 – 8, 10 – 14, and 16 of copending Application No. 10/512,782 has been maintained.

### ***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 13 – 17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawabata et al. (US 5,626,694).

Kawabata is applied to claims 13 – 17, 20, and 21 as set forth in the December 23, 2008 Office action.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 13 – 17, 20, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 8, 10 – 14, and 16 of copending Application No. 10/512,782 as set forth in the December 23, 2008 Office action.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

9. Applicant's arguments filed May 13, 2009 have been fully considered but they are not persuasive.

Arguments and the Examiner's responses are as follows:

a. According to Kawabata, W is not an indispensable element, contrary to Applicant's claim 13. Instead, W is an optionally added element in Kawabata and as for the examples of Kawabata, out of 101 examples, there is only one example containing W. It has a value of W: 1.5% which is outside the range of W (2.0 to 6.0%) recited in the Applicants' claim 13. The relationship between the amount of precipitated W and thermal expansion coefficient in Kawabata, which is an inventive aspect of claim 13, is not disclosed at all.

Kawabata is not required to teach the same benefits as the instant invention. See MPEP 2144 IV. Furthermore, the scope of Kawabata is not limited to the specific embodiments it teaches (see *In re Fracalossi* 215 USPQ 569 (CCPA 1982)). Therefore, the Examiner maintains the position set forth in the 12/23/2008 Office action that since the claimed compositional ranges either overlap or are within the ranges disclosed by Kawabata, a prima facie case of obviousness exists.

b. Kawabata is directed to completely different subject matter. Kawabata is related to a process for manufacturing stainless steel sheets to be used as

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building materials, materials for automobiles, materials for chemical plants and the like, in particular, stainless steel sheets having a more excellent corrosion resistance. Applicant's steel sheets are suitable for applications in which a heat cycle is repeated between high temperature and low temperature including exhaust system members of an automobile such as exhaust manifolds and many other applications.

As discussed above, Kawabata is not required to teach the same benefits or solve the same problem as the instant invention. See MPEP 2144 IV.

c. The instant invention requires a specific hot rolled sheet annealing temperature of 950°C to 1150°C (more preferably 1020°C to 1200°C) so that precipitated W is 0.1% or less in percent by mass. Kawabata disclosed annealing based on an ordinary method only and there is no disclosure of any concrete description of annealing temperature.

As discussed in the 12/23/2008 Office action, col. 6 line 63-col. 7 line 5 of Kawabata teaches that the final annealing temperature is 700°C-1300°C which overlaps with the temperature range recited in the instant claim.

d. The inherency rejection is based on the premise of a "similar" method. However, there is a significant difference between the method of Kawabata and the method of the instant invention. For example, Applicants' annealing is for three minutes, while the Kawabata annealing is ten seconds. Those skilled in the art would readily know that there are significant differences between annealing for ten seconds and three minutes which can impact any number of

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characteristics of the steels. Furthermore, Kawabata teaches that the first annealing process is followed by a second annealing process and Applicants do not teach this. This is sharply different from Applicants' claimed methodology and those skilled in the art would reasonably expect that the final characteristics of the steels between the Applicants and Kawabata would likely, inherently be different, not inherently the same.

Applicant has not submitted factual evidence to support the argument that an annealing time of three minutes would produce a significantly different product than an annealing time of ten seconds. In addition, Kawabata does not require more than one annealing step as taught in col. 6 lines 54-62 and claim 1 of Kawabata which both teach only one annealing step. Although an Example in Kawabata teaches two annealing steps, the scope of Kawabata is not limited to the specific embodiments it teaches (see *In re Fracalossi* 215 USPQ 569 (CCPA 1982)). Therefore, in the absence of evidence to the contrary, the Examiner maintains the position that since the composition of the ferritic-Cr-contained steel of Kawabata overlaps with the composition of the steel of the instant invention and since the steel of Kawabata is made using a method similar to the method of the instant invention, one of ordinary skill in the art would expect the steel of Kawabata to inherently have similar physical and mechanical properties.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is

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(571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

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